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EXAMINER

GARLAND, STEVEN R

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 07/10/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/466,282

Applicant(s)

RUBEN ET AL.

Examiner

Steven R Garland

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6-9,11,18 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-9,11,18,21-23,25 and 26 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 21-23, 25, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25 and 26 are incomplete, since they depend on a canceled claim.

In claim 21, line 2, " said computer " and " the pharmacy name " lack a clear antecedent basis.. Claim 22 has similar problems.

Claim 23, line 3, " the pharmacist's inventory " lacks a proper antecedent basis.

3. In the rejections that follow it is assumed that claims 25 and 26 are dependent on claim 9.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6-9,11,18,21-23,25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel 4,732,411 in view of Kutsuma 5,905,652 and Foote et al. 5,642,906.

Siegel teaches using a label having a miniature photograph of the patient on a prescription container. Siegel teaches that the picture is taken of the patient and then

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stored in computer memory so that it can be produced on demand. See the abstract; figure 1; col. 2, lines 1-64; col. 3, lines 1-66; and claim 1.

Siegel however does not specifically state that two computers can be used; that databases are used, that a laser printer is used, or that a digital camera is used.

Kutsuma teaches the use of a digital camera; inputting a picture into a computer; transmitting a picture from one computer to another computer and combining the picture with other prescription information and printing the combined information. Kutsuma also teaches storing the picture and prescription information in separate memories which form databases. Kutsuma also teaches that if the required picture is not stored in memory taking a picture and storing the picture in memory. See fig. 6; col. 4, lines 26-48; col. 6, lines 13-27.

It would have been obvious to one of ordinary skill in the art to modify Siegel in view of Kutsuma to use a printer, camera, databases, and multiple computers as taught by Kutsuma to produce a label with a patient picture and other information such as medication pictures and prescription information. This would allow printing a label at various locations in case a printer fails or sending the information to different pharmacies and insure the correct patient receives the correct medications.

Siegel and Kutsuma however do not teach the use of an inventory database or laser printer.

Foote et al. teaches the use of a laser printer and of plural databases including an inventory database during formation of a label. Foote also teaches including the

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name and address of the pharmacy on the label. See the abstract; figures; col. 2, lines 1-12; col. 2, line 53 to col. 3, line 25. Note figure 4.

It would have been obvious to one of ordinary skill in the art to modify Siegel and Kutsuma in view of Foote and use plural databases including an inventory database to form the label and use a laser printer to print the label. This would allow all the desired and needed information to be easily gathered and printed on the label.

Further it would have been obvious to one of ordinary skill in the art to update the inventory database of Siegel, Kutsuma, and Foote as the inventory changes so as to have an accurate record of the inventory and allow ease in determining when to reorder replacement quantities and to track controlled substances.

6. Claims 1, 6-9, 11, 18, 21-23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloning WO99/17218 in view of Kutsuma 5,905,652 and Foote et al. 5,642,906.

Cloning discloses use of a digital camera to take a picture of the patient; electronically digitizing, storing, and accessing the image of the patient; tracking order, issue, and administration of medication for billing purposes; transmitting prescription and picture information from a system computer to the pharmacy computer where the prescription is filled and a label is generated with a patient picture. See the abstract; pages 3, 4, 6, 9, 11-16, 18-20 and the figures.

Cloning however does not teach the use of separate databases or the use of laser printer to implement the printer.

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Kutsuma teaches the use of a digital camera; inputting a picture into a computer; transmitting a picture from one computer to another computer and combining the picture with other prescription information and printing the combined information. Kutsuma also teaches storing the picture and prescription information in separate memories which form databases. Kutsuma also teaches that if the required picture is not stored in memory taking a picture and storing the picture in memory. See fig. 6; col. 4, lines 26-48; col. 6, lines 13-27.

It would have been obvious to one of ordinary skill in the art to modify Cloninger in view of Kutsuma and use separate databases for the various types of information so that it could be easily modified and retrieved.

Cloninger and Kutsuma however do not teach the use of an inventory database or laser printer.

Foote et al. teaches the use of a laser printer and of plural databases including an inventory database during formation of a label. Foote also teaches including the name and address of the pharmacy on the label. See the abstract; figures; col. 2, lines 1-12; col. 2, line 53 to col. 3, line 25. Note figure 4.

It would have been obvious to one of ordinary skill in the art to modify Cloninger and Kutsuma in view of Foote and use plural databases including an inventory database to form the label and use a laser printer to print the label. This would allow all the desired and needed information to be easily gathered and printed on the label.

Further it would have been obvious to one of ordinary skill in the art to update the inventory database of Cloninger, Kutsuma, and Foote as the inventory changes so as

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to have an accurate record of the inventory and allow ease in determining when to reorder replacement quantities and to track controlled substances.

7. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 703-305-9759. The examiner can normally be reached on Monday –Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (703) 308-0538. The fax phone number for

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the organization where this application or proceeding is assigned is 703-746-7239; for after final faxes 703-308-7238; and for non official faxes 703-746-7240.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3900.

*SRG*

Steven R Garland  
Examiner  
Art Unit 2125

*L. P. Picard*

LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100